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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,448	01/31/2000	Lester F. Lau	287758/36072	4869

7590

06/17/2002

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EXAMINER

BRUMBACK, BRENDA G

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 06/17/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/495,448

Applicant(s)

LAU, LESTER F.

Examiner

Brenda G. Brumback

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 9-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 6-8, and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This action is responsive to the amendment filed 03/02/2002. Claim 5 was canceled. Claims 4, 6, and 8 were amended. Claim 24 was added. Claims 1-4 and 6-24 are pending. Claims 1-3 and 9-23 have been withdrawn from consideration as directed to a nonelected invention. Claims 4, 6-8 and 24 are under examination on the merits.

For clarification of the record it is noted that the pending claims are 2-4 and 6-24, not 4 and 6-9 and the newly added claim is numbered as 24, not 9, as was stated in applicant's response.

Specification

The objection to the specification for the use of the trademarks is maintained. Applicant has neither amended the disclosure nor presented arguments in response to the rejection. The specification should be reviewed for capitalization of the trademarks and for accompanying generic terminology.

Claim Objections

The objection to claim 5 is moot, as the claim has been canceled.

Claim Rejections - 35 USC § 112

The rejection of claims 5, 6, and 8 under 35 U.S.C. 112, second paragraph, is withdrawn subsequent to applicant's amendment or cancellation thereof.

Claim Rejections - 35 USC § 103

The rejection of claims 4 -8 rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamoto et al. in view of O'Brien et al. and Bork and Lin et al. is withdrawn. Applicant's arguments were persuasive.

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The rejection of claims 4 -8 rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamoto et al. in view of Yang G.P. and Lin et al. is maintained for claims 4 and 6-8 for the reasons of record.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamoto et al. in view of Yang and Lin et al. for the reasons of record and additionally because Iwamoto teaches that basement membrane gels contain laminin and heparin sulfate proteoglycan, as well as other proteins (see page 142, second full paragraph).

Applicant's arguments have been fully considered but they are not persuasive for the following reasons.

Applicant argues that the teachings of Yang have been overstated because Yang et al. teach that the chemoattractant activity in serum stimulated NIH3T3 cells may be related to Cyr61, but states that further work is needed to refine knowledge of how Cyr61 and its family members function in biological processes. Yang, however, points directly to the claimed method wherein Cyr61 is used as the chemoattractant in the method of screening for modulators of cell migration which is disclosed by Iwamoto, by stating that the chemoattractant factor in the conditioned medium of NIH 3T3 cells used by Iwamoto is related to Cyr61 (see the abstract, lines 6-7). Applicant is reminded that absolute predictability is not required, but rather a reasonable expectation of success. The combined teachings of the art provide such a reasonable expectation of success. The fact that Yang teaches that further work will refine knowledge of how Cyr61 and its family members function in biological processes does nothing to teach away from the disclosure that it is a chemoattractant.

Applicant alleges that Yang speculates that Cyr61 may be a chemoattractant based solely on the fact that database analysis identified Cyr61 as a member of a family of known chemoattractants. However, Yang states, "We have also found a chemoattractant activity in serum stimulated NIH 3T3 cells that may be related to Cyr61". Absent some evidence to the contrary, Yang is disclosing confirmed chemoattractant activity, not mere speculation based on sequence analysis.

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Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Brumback whose telephone number is (703) 306-3220. If the examiner can not be reached, inquiries can be directed to Supervisory Patent Examiner Anthony Caputa whose telephone number is (703) 308-3995. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Examiner Brenda Brumback, Art Unit 1642 and should be marked "OFFICIAL" for entry into prosecution history or "DRAFT" for consideration by the examiner without entry. The Official FAX telephone number is (703) 872-9306 and the After Final FAX telephone number is (703) 872-9307. FAX machines will be available to receive transmissions 24 hours a day. In compliance with 1096 OG 30, the filing date accorded to each OFFICIAL fax transmission will be determined by the FAX machine's stamped date found on the last page of the transmission, unless that date is a Saturday, Sunday or Federal Holiday with the District of Columbia, in which case the OFFICIAL date of receipt will be the next business day.


Brenda Brumback
Primary Examiner

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.